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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/513,818 | 02/24/2000 | Scott Harvey Demsky | AUS990886USI | 7815 |

7590 12/31/2003

Marilyn Smith Dawkins
International Business Machines Corporation
Intellectual Property Law Department, Internal
11400 Burnet Road
Austin, TX 78758

| EXAMINER |
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THEIN, MARIA TERESA T

| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/513,818

Applicant(s)

DEMSKY ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,9,11-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,9,11-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 13 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 21, 2003 has been entered.

Response to Amendment

Applicant's "Request for Continued Examination..." deposited on August 21, 2003 has been considered.

Applicant's response to terms "canceling a committed transaction" has overcome the Examiner's rejection of such claims under 35 USC 112, second paragraph.

Claims 1,4, 5, 9, and 13 have been amended. Claims 15, 16, and 17 have been added. Claims 3, 6-8, 10, and 14 have been cancelled. Claims 1-2, 4-5, 9, 11-13, and 15-17 remain pending and an action on the merits of these claims follows.

Response to Arguments

Applicant's arguments with respect to claims 1-2, 4-5, 9, 11-13, and 15-17 have been considered but are moot in view of the new ground(s) of rejection.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on September 3, 2003 is being considered by the examiner.

Claim Objections

Claim 12 is objected to because of the following informalities: "The system of claim 10" should be --The system of claim 9--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-2, 4-5, 9, 11-13, and 15-17 are rejected under 35 U.S.C. 102(a) as being anticipated by Japan Patent No. 11-154176 to Okada.

Regarding claims 1 and 13, Okada discloses a method and a computer program code means, over a communication of interconnecting computers, electronic transactions between a plurality of merchants using at least one server computer and at least one buyer using a client computer (see at least paragraph 1) comprising:

- displaying, at the client computer, a separate representation for each item selected by the buyer from at least one merchant, wherein each separate representation has an associated one of a plurality of selectable states, and wherein a certain one of the plurality of selectable states indicates that the buyer desires to purchase an item from a first merchant if a previous committed

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transaction which bought another previous item from a second merchant can be canceled (see at least paragraphs 13, 15-16, 25-26, 43, 46-47, 51, and 56-67);

- displaying an indication of the one associated selectable state with each displayed separate representation (see at least Figures 6-7; paragraphs 9, 13, 16, 43, and 46-47); and
- selecting one of the displayed separate representations to have a selectable associated state that indicates that the buyer desires to purchase a desired item from the first merchant if a given previously committed transaction which bought another previous item from the second merchant can be canceled (see at least Figures 6-7; paragraphs 11-13, 16, 25-27, 43, 46-48, 51, 56-57 and 60);
- response to selecting:
 - making an identification of the second merchant and the previous item (see at least paragraphs 15-16, 44-45, 56),
 - sending an electronic communication to the second merchant from the first merchant to cancel the previous committed transaction (see at least paragraphs 16, 43-48, and 56-60), and
 - if a confirmation is received indicating that the previous committed transaction was cancelled by the merchant, automatically changing the state of the first item to a state different from the conditional state, wherein further transaction processing to purchase the first item is dependent upon the changed state as a result of a successful cancellation transaction of the previous item carried out by the first

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merchant on behalf of the buyer an initiated by the buyer by selecting the conditional state in association with the first item (see at least 13, 16, 43-48, and 56-60).

Regarding claim 2, Okada discloses a method for carrying out, over a communication of interconnecting computers, electronic transactions between a plurality of merchants using at least one server computer and at least one buyer using a client computer (see at least paragraph 1) comprising:

- enabling the client computer to display a separate representation of each item selected by the buyer from at least two different merchants wherein each representation has one of a plurality of associated states at a given instance in time (see at least paragraphs 11, 13, 28, 30-31, 36-37);
- displaying an indication of the one associated selectable state with each displayed separate representation (see paragraphs 13, 16, 30-31, and 36-37); and
- selecting by the buyer, one of the displayed separate representations to have a selectable associated state that indicates that the buyer desires to purchase a desired item if a previous committed transaction which bought another item from another merchant can be canceled (see at least paragraphs 13, 16, 43, 44-48, 53, 56-57 and 60).

Regarding claims 4 and 11, Okada discloses the selected associated state causes an indication to be sent from the client computer to the first merchant to lock specific data associated with the desired item from being accessible by a different client

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computer during a period that an associated representation for the desired item has the selected associated state (see at least Figures 6-7; paragraphs 9, 11, 13, 15-16, 25, 43, 46-47, and 51).

Regarding claim 5, Okada discloses the different state provides an indication of one of the following: the buyer desires to put the desired item on hold for a time to consider buying the desired item, and the buyer has bought the desired item (see at least paragraphs 9, 11, 13, 15-16, 28, 30-37, and 46-47).

Regarding claim 9, Okada discloses a client computer system enabled to communicate over a network with at least one server computer system for carrying out electronic transactions for a buyer using the client computer system for the purchase of items from a plurality of merchants using the at least one server computer system, the client computer system comprising:

- a storage device having a set of instructions (see at least paragraphs 18-20, 22-23, 25-25); and
- a processing unit, connected to the storage device, wherein the processing unit executes the set of instructions (see at least paragraphs 18-20, 22-23, 25-25) for:
 - displaying a separate representation for each item selected by the buyer from at least two different merchants, wherein each separate representation has an associated one of a plurality of selectable associated states at a given instance in time, and wherein a certain one of the plurality of selectable associated states indicates that the buyer desires to purchase an item from a first merchant if a previous

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committed transaction which bought another item from a second merchant can be cancelled (see at least paragraphs 13, 15-16, 25-26, 43, 46-47, 51, and 56-67);

- displaying an indication of the one associated selectable state with each displayed separate representation (see at least Figures 6-7; paragraphs 9, 13, 16, 43, and 46-47); and
 - executing a selection, by the buyer, of a desired item from a certain merchant causing one of the displayed separate representations to have a selectable associated state that indicates that the buyer desires to purchase the desired item if a given previously committed transaction which bought another item from another merchant can be canceled (see at least Figures 6-7; paragraphs 11-13, 16, 25-27, 43, 46-48, 51, 56-57 and 60);
- response to selecting:
 - making an identification of the second merchant and the previous item (see at least paragraphs 15-16, 44-45, and 56),
 - sending an electronic communication to the second merchant from the first merchant to cancel the previous committed transaction (see at least paragraphs 16, 43-48, and 56-60), and
 - if a confirmation is received indicating that the previous committed transaction was cancelled by the merchant, automatically changing the state of the first item to a state different from the conditional state,

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wherein further transaction processing to purchase the first item is dependent upon the changed state as a result of a successful cancellation transaction of the previous item carried out by the first merchant on behalf of the buyer and initiated by the buyer by selecting the conditional state in association with the first item (see at least 13, 16, 43-48, and 56-60):

Regarding claim 12, Okada discloses means for changing the selected state to a different state, upon notification of the cancellation, wherein the different state provides an indication of one of the following: the buyer desires to put the desired item on hold for a time to consider buying the desired item, and the buyer has bought the desired item (see at least Figures 6-7; paragraphs 9, 11, 13, 15-16, 28, 30-37, 46-47, and 56-60).

Regarding claims 13-15, Okada discloses a method, system and program comprising:

- means for sending to the client computer, a separate representation for each item selected by the buyer (see at least paragraphs 13, 15, 25-26, 43, 46-47, 51, and 56-67);
- means for associating, on of a plurality of selectable states selected by the buyer with each separate representation (see at least Figures 6-7; paragraphs 9, 13, 16, 43, and 46-47);
- in response to associated a conditional state selected by the buyer with a displayed first item, wherein the selected conditional state is indicative of the

buyer desiring to purchase the first time form the first merchant if a previous committed transaction which bought a previous item form a second merchant can be canceled (see at least Figures 6-7; paragraphs 11-13, 16, 25-27, 43, 46-48, 51, 56-57 and 60):

- means for receiving an identification of the previous item and the second merchant (see at least paragraphs 15-16, 44-45, and 56);
- means for sending an electronic communication to the second merchant from the first merchant to cancel the previous committed transaction (see at least paragraphs 16, 43-48, and 56-60); and
- if a confirmation is received indicating the previous committed transaction was canceled by the second merchant, means for automatically changing the state of ht first item to a state different from the conditional state, wherein further transaction processing enabling a purchaser of the first item is dependent upon the state changing as a result of a successful cancellation transaction of the previous item carried out by the first merchant on behalf of the buyer as initiated by the buyer by selecting the conditional state in association with the first item (see at least 13, 16, 43-48, and 56-60).

Conclusion

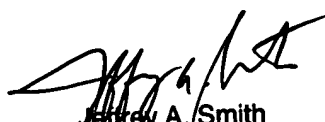
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

mtot
December 11, 2003



Jeffrey A. Smith
Primary Examiner